UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,372	09/15/2003	Joerg Beringer	09282.0008-00	1628

60668   7590   04/28/2009
SAP / FINNEGAN, HENDERSON LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

EXAMINER
MCCORMICK, GABRIELLE A

ART UNIT	PAPER NUMBER
3629	

MAIL DATE	DELIVERY MODE
04/28/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 March 2009*.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☐ Claim(s) *1-26,28,30 and 32* is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *1-26,28,30 and 32* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All   b)☐ Some * c)☐ None of:
        1.☐ Certified copies of the priority documents have been received.
        2.☐ Certified copies of the priority documents have been received in Application No. _____.
        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date *3/18/2009*.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Status of Claims

1. This action is in reply to the amendment filed on March 18, 2009.

2. Claims 1, 14, 25 and 26 have been amended.

3. Claims 27, 29, 31 and 33 have been canceled.

4. Claims 1-26, 28, 30, 32 and 34 are currently pending and have been examined.

Continued Examination Under 37 CFR 1.114

5. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 18, 2009 has been entered.

Information Disclosure Statement

6. The Information Disclosure Statement filed on March 18, 2009 has been considered. An initialed copy of the Form 1449 is enclosed herewith.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 1-24, 28 and 30 are rejected as being directed to non-statutory subject matter. Claims 1 and 14 are method claims that recite process steps that are not tied to a particular machine. Based on recent Federal Circuit decision (see *In re Bilski*), an applicant may show that a process

claim satisfies 35 USC 101 either by showing that his claim is tied to a particular machine, or by showing that his claim transforms an article. (See Benson, 409 U.S. at 70). First, as illustrated by Benson, the use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility. (See Benson, 409 U.S. at 71-72). Second, the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity. (See Flook, 437 U.S. at 590).

9.   Claims 1 and 14 recite a method performed by a computer system in the preamble, however, structural elements solely recited in the preamble are not accorded patentable weight. To overcome this rejection, the structural elements should be recited as part of the body of the claim.

10.   Additionally, claims 1 and 14 recite editing data stored in the computer system. This limitation does not positively claim the use of the computer system for the editing of the data or the personalizing of the work environment. At most, the storage of data in the computer system is considered insignificant extra-solution activity.

11.   Because the applicable test to determine whether a claim is drawn to a patent-eligible process under 35 USC 101 is the machine-or-transformation test set forth by the Supreme Court, claims 1 and 14 fail that test and are therefore rejected under 35 USC 101.

Claim Rejections - 35 USC § 103

12.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

13.   **Claims 1-4, 8-9, 12-15, 19-22, 25-26, 28, 30, 32 and 34** are rejected under 35 U.S.C. 103(a) as being unpatentable over Howard et al. (US Patent No. 6,697,865 hereafter referred to as "Howard") in view of Case et al. (US Pub. No. 2003/0154180, hereinafter referred to as "Case").

14.   **Claims 1, 8 and 25:** Howard discloses providing portals that simultaneously "present a single coordinated image to selling partners and customers while providing custom experiences for individual users." (C2; L9-11).   Howard discloses "relationship portal software" and "business database" (C2; L35-47: *machine readable instructions*).   Howard also discloses an example of context information where a sales person manages the permissions for users, one of which is a lawyer.   The sales person can set the lawyer's permissions, but would not have access to the legal content. (C8; L9-13).   Thus, the lawyer has access to legal content (and therefore the context information appropriate to a lawyer's permissions).   Additionally, Howard discloses:

- *generating a user profile corresponding to a user;* (C4; L35-42)

- *identifying one or more entities related to the user, said one or more entities having corresponding entity profiles including context information comprising a plurality of types of categorization data;* (C4; L27-35: The company (i.e., entity/parent) profile includes demographic data, lists of affiliated companies, a list of permissions that users can be given, and a list of users who are allowed to manage the profile.   These are examples of a plurality of types of categorized data.)

- *associating at least a portion of the context information from the one or more related entity profiles to the user profile by importing at least the portion of the context information into the user profile, wherein the imported portion comprises data belonging to the plurality of types of categorized data;* (C2; L42-48: relationships between parties are regulated to the extent that the relationship involves the portal-providing company's (i.e., an example of a parent company) information: thus, parent company information (i.e., context information) is provided (i.e., imported) to a child company thru the relationship. C2; L8-11: the interaction of the portal providing company and other companies results in presenting a "single coordinated image" while providing custom experiences for individual users, Thus describing the functionality such that context information is imported into a user profile such that the user views the "single coordinated image" while also having a custom experience (i.e., one that results from the user's preferences from the user's profile).   C5; L38-50:   "Once the

permission has been given to a group it is automatically conferred on all members of that group...Any user who becomes a member of a group immediately acquires all the permissions that have been given to the group. The use of groups simplifies administration of permission by enabling a large number of permissions to easily be assigned by putting users in just a few groups." The "permissions" constitute an example of categorized context information from the plurality of types of categorized data listed at C4; L27-35 (The company (i.e., entity/parent) profile includes demographic data, lists of affiliated companies, a list of permissions that users can be given, and a list of users who are allowed to manage the profile. These are examples of a plurality of types of categorized data.) The step of immediately acquiring group permissions by users discloses the importing (i.e., transporting or inheriting) of the context information into the profile of the user. (C4; L35-41: A user profile includes demographic data, permissions and preferences, therefore, the user profile contains a plurality of types of categorized data. C4; L44-46: "the maximum permissions available to a user are limited by the permission assigned to the user's company" thus, the categorized data of permissions is imported and associated with the user's profile.) C7; L67-C8; L4: a selling partner of the portal-providing company can create personalized branded web sites for its customers and can reuse (i.e., import) information available on the portal-providing company's portal.)

- *personalizing a work environment associated with user based on the context information associated with the user profile.* (C2; L56-67: a personal relationship portal that has custom appearances and behaviors for each of the employees). Permissions are provided to modify profiles (C6; L40-50).

15.   Howard explicitly discloses that permissions of a user are based on group or company permissions and are therefore imported/inherited from that parent. These permissions impact the accessibility of the user to various types of data. Howard does not explicitly disclose importing at least an additional type of data from an at least type of categorized data because this is accomplished by the permissioning.

16.   Case discloses that a user profile is generated based on the job description of the user such that

the interests and memberships associated with the user group having a particular job description

are assigned to the user. (P[0033]). Roles have profiles that are included in the relevant user's

profile. (P[0041-0042]). Case further discloses that all members of a team (i.e., people working

on the same project) are assigned an identical profile. (P[0092]). This discloses importing

categorized data that belongs to a group membership, an information need of the user, a project

of the user and a task on the user.

17.   Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention

to have included explicitly importing other aspects of a profile to a user's profile, such as a group

membership and a project, as disclosed by Case, in the system of Howard for the motivation of

conveniently assigning certain interests and memberships of user groups as a function of their job

description. (Case; P[0033]). Howard discloses that the user interface presented to a given user

depends on the user's role and on user and company profiles. (C12; L38-41). Therefore, it is

obvious to expand Howard to explicitly define that the permissioning that is imported to a user

profile based on a role includes other profile information associated with the role.

18.   Note: Though the Examiner has applied art to the category of authorization level, the various

categories of data (qualifications, skills, preferences, authorization level, group memberships,

informational needs, projects, tasks, taxonomies and accessed content) are **nonfunctional

descriptive data** and are not functionally involved in the steps recited. **The importing of

categorized data would be performed regardless of descriptions of the categories.** Thus,

this descriptive data will not distinguish the claimed invention from the prior art in terms of

patentability, *see In re Gulack,* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re

Lowry,* 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

19.   Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention

was made to have included various specified categories of data because such data does not

functionally relate to the steps in the method claimed and because the subjective interpretation of

the names of the categories does not patentably distinguish the claimed invention.

20.   **Claims 14, 19 and 26:** Howard discloses providing portals that simultaneously "present a single coordinated image to selling partners and customers while providing custom experiences for individual users." (C2; L9-11). Howard discloses "relationship portal software" and "business database" (C2; L35-47: *machine readable instructions*). The relationship between the company (parent) and the user (*child*) is disclosed by Howard in column 4; lines 27-29: "a profile for a company to which a user belongs must exist before a profile for the user can be created." Howard also discloses an example of context information where a sales person manages the permissions for users, one of which is a lawyer. The sales person can set the lawyer's permissions, but would not have access to the legal content. (C8; L9-13). Thus, the lawyer has access to legal content (and therefore the context information appropriate to a lawyer's permissions). Additionally, Howard discloses:

- *generating a child entity profile corresponding to a child entity;* (C4; L35-42)

- *identifying a parent entity profile from which the child entity profile depends, the parent entity profile including context information comprising a plurality of types of categorization data;* (C4; L27-35: The company (i.e., entity/parent) profile includes demographic data, lists of affiliated companies, a list of permissions that users can be given, and a list of users who are allowed to manage the profile. These are examples of categorized data.)

- *importing at least a portion of the context information from the parent entity profile into the child entity profile, said imported context information comprising inherited context information belonging to the plurality of types of categorized data;* (C2; L42-48: relationships between parties are regulated to the extent that the relationship involves the portal-providing company's (i.e., an example of a parent company) information: thus, parent company information (i.e., context information) is provided (i.e., imported) to a child company thru the relationship. C2; L8-11: the interaction of the portal providing company and other companies results in presenting a "single coordinated image" while providing custom experiences for individual users, Thus describing the functionality such that context information is imported into a user profile such that the user views the "single coordinated image" while also having a

custom experience (i.e., one that results from the user's preferences from the user's profile). C5; L38-50: "Once the permission has been given to a group it is automatically conferred on all members of that group...Any user who becomes a member of a group immediately acquires all the permissions that have been given to the group. The use of groups simplifies administration of permission by enabling a large number of permissions to easily be assigned by putting users in just a few groups." The "permissions" constitute an example of categorized context information from the plurality of types of categorized data listed at C4; L27-35 (The company (i.e., entity/parent) profile includes demographic data, lists of affiliated companies, a list of permissions that users can be given, and a list of users who are allowed to manage the profile. These are examples of a plurality of types of categorized data.) The step of immediately acquiring group permissions by users discloses the importing (i.e., transporting or inheriting) of the context information into the profile of the user. (C4; L35-41: A user profile includes demographic data, permissions and preferences, therefore, the user profile contains a plurality of types of categorized data. C4; L44-46: "the maximum permissions available to a user are limited by the permission assigned to the user's company" thus, the categorized data of permissions is imported and associated with the user's profile.) C7; L67-C8; L4: a selling partner of the portal-providing company can create personalized branded web sites for its customers and can reuse (i.e., import) information available on the portal-providing company's portal.)

- *updating the inherited context information in the child entity profile in response to a change in the corresponding at least a portion of the context information in the parent entity profile. (C4; L49-51: when company permissions are removed, all employee permissions are removed. A specific example of a context based permission that is updated is disclosed in C13; L21-34). Permissions are provided to modify profiles (C6; L40-50).*

21.   Howard explicitly discloses that permissions of a user are based on group or company permissions and are therefore imported/inherited from that parent. These permissions impact the accessibility of the user to various types of data. Howard does not explicitly disclose importing at

least an additional type of data from an at least type of categorized data because this is accomplished by the permissioning.

22.   Case discloses that a user profile is generated based on the job description of the user such that the interests and memberships associated with the user group having a particular job description are assigned to the user. (P[0033]). Roles have profiles that are included in the relevant user's profile. (P[0041-0042]). Case further discloses that all members of a team (i.e., people working on the same project) are assigned an identical profile. (P[0092]). This discloses importing categorized data that belongs to a group membership, an information need of the user, a project of the user and a task on the user.

23.   Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included explicitly importing other aspects of a profile to a user's profile, such as a group membership and a project, as disclosed by Case, in the system of Howard for the motivation of conveniently assigning certain interests and memberships of user groups as a function of their job description. (Case; P[0033]). Howard discloses that the user interface presented to a given user depends on the user's role and on user and company profiles. (C12; L38-41). Therefore, it is obvious to expand Howard to explicitly define that the permissioning that is imported to a user profile based on a role includes other profile information associated with the role.

24.   Note: Though the Examiner has applied art to the category of authorization level, the various categories of data (qualifications, skills, preferences, authorization level, group memberships, informational needs, projects, tasks, taxonomies and accessed content) are **nonfunctional descriptive data** and are not functionally involved in the steps recited. **The importing of categorized data would be performed regardless of descriptions of the categories.** Thus, this descriptive data will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack,* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry,* 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

25.   Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included various specified categories of data because such data does not

functionally relate to the steps in the method claimed and because the subjective interpretation of the names of the categories does not patentably distinguish the claimed invention.

26.   **Claims 2 and 20:**   Howard discloses explicitly associating context information relating to the user/child entity with the user/child entity profile. (C11; L9-11: the user profile includes preferences and C11; L37-41: the user purposely modifies the user preferences).

27.   **Claims 3 and 21:**   Howard discloses a configuration function that identifies and creates profiles for companies and employees.   The configuration information is kept in a "portal management database **23**". (C3; L11-19).   Data is gathered from the database by a Java class library.   (C3; L48-58).   A *context cluster* is understood to be a compilation of data, such as found in database tables, therefore the functionality of the Java class library in gathering data is equivalent to creating a *context cluster*.

28.   **Claim 4:**   Howard discloses *transporting one or more context clusters into the user profile*. (C4; L45-51: the permissions of a user are limited to the permissions assigned to a company).

29.   **Claims 9 and 22:**   Howard discloses changing a company profile or modifying a user profile. (C6; L44-47 and C8; L20-37:   a change in the company permissions leads to changing (i.e., updating) user permissions).

30.   **Claims 12 and 13:**   Howard discloses collaborative and business relationships.   (C13; L21-34).

31.   **Claim 15:**   Howard discloses *personalizing a work environment associated with user based on the context information associated with the user profile*.   (C2; L56-67: a personal relationship portal that has custom appearances and behaviors for each of the employees).

32.   **Claims 28, 30, 32 and 34:**   Howard discloses an employer-employee relationship (C4; L52-55). Such a relationship is construed to be based on the activities, workset and collaboration of the user with the entity.

33.   <u>Claims 5-7, 10-11, 16-18 and 23-24</u> are rejected under 35 U.S.C. 103(a) as being unpatentable over Howard et al. (US Patent No. 6,697,865 hereafter referred to as "Howard") in view of Case et al. (US Pub. No. 2003/0154180, hereinafter referred to as "Case") in view of Hosea et al. (US Pub. No. 2002/0138331 hereafter referred to as "Hosea").

34.   **Claims 5, 6, 7, 16, 17 and 18:** Howard/Case discloses the limitations of claims 1 and 14. Howard does not disclose *links* to *services* and *information places.*

35.   Hosea, however, discloses a system for personalizing Web pages to meet the interests of Web users based on user profiles. (Abstract).   Hosea discloses links to "Yahoo! Shopping" (i.e., a service) and "News & Media" (information places) in Figure 11.

36.   Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included links to services and information, as disclosed by Hosea in the system disclosed by Howard, for the motivation of providing a method of allowing the user to "more quickly and easily locate material that is most likely to be of interest" (Hosea; P[0050]).

37.   **Claims 10, 11, 23 and 24:** Howard/Case discloses the limitations of claims 9 and 22. Howard does not disclose determining relevance of context information and removing based on the relevance.

38.   Hosea, however, discloses determining the relevance of content to the user based on an affinity rating (P[0047]). The affinity rating is generated by analyzing the user's Web surfing and click-stream data (P[0042]). Content deemed not to be of interest to the user is eliminated (P[0050]).

39.   Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included eliminating content based on relevance to the user, as disclosed by Hosea, in the system of Howard for the motivation of reducing "what may be perceived by a user as clutter" and simplifying the presentation of the information such that the user can "more quickly and easily locate material that is most likely to be of interest" (Hosea; P[0050]).

Response to Arguments

40.   Applicant's arguments with respect to claims 1, 14, 25 and 26 have been considered but are moot in view of the new ground(s) of rejection.

41.   With regard to the use of the term, "importing", Applicant's specification discloses, "Context information may also be "inherited", e.g., by importing context data from a parent entity profile into a depending child entity profile. The context information may be organized into context clusters, which may then be transported from the related entity profile(s) into the user profile." (P[0006]). Thus, the term, "importing" is not construed to be limited as to how the "importing" takes place. Howard explicitly states that once "the permission has been given to a group it is automatically conferred on all members of that group." Thus, the group (i.e., parent) permission is imported/inherited/transported to the individual (i.e., child).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gabrielle McCormick whose telephone number is (571)270-1828. The examiner can normally be reached on Monday - Thursday (5:30 - 4:00 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/G. M./
Examiner, Art Unit 3629

/JOHN G WEISS/
Supervisory Patent Examiner, Art Unit 3629